

**Remarks/Arguments**

The instant amendment re-submits the corrected section “Amendments to the claims” in order to reflect the claim numbering set forth in the Office communication.

For the record, however, it must be pointed out that the original claims of the subject PCT national stage application are claims 1-19 found in the Annexes attached to the International Preliminary Examination Report (IPER). A copy of the IPER, including the annexes in the original German and translated into English, was filed with the subject national stage application.

The Office communication incorrectly maintains there are 20 original claims and that the claim numbering reflected in the Amendment filed September 8, 2003, is incorrect. While there were twenty claims in the originally filed *international* application, they were replaced during the international stage by (amended) claims 1-19. This was, in fact, pointed out in the remarks/arguments of the previously filed amendment (page 6, third complete paragraph).

On the other hand, since the Office insists on numbering the claims in a manner that does not accurately reflect the number of claims originally filed, the claims are renumbered accordingly, hereby, in order to expedite prosecution.

For the convenience of the examiner, the remarks/arguments of the previously filed amendment are substantially repeated, below, with any claim numbers changed to reflect the changes to claim numbering effected, hereby.

Present claims 21-37 replace the original claims canceled without prejudice or disclaimer hereby.

Present claims 21-37 correspond to original claims 1-17 (as found in the Annexes to the IPER), revised to more clearly define the instant invention, i.a., in order to address issues raised in the statement of rejection under 35 USC 112, paragraph 2, as explained below.

In accordance with present (replacement) claim 21, the terms "residence" and "chamber" replace the words "dwelling" and "space," recited in corresponding original claim 1, the replacement terms being more readily recognized. This is more or less suggested, apparently, by the Examiner (Office Action, page 6, second paragraph, line 4 and 5).

In accordance with present (replacement) claim 24, the term "vaporization" replaces "atomization," i.e., found in corresponding claim 4. The fuel is vaporized to yield an "aerosol-like" state and, so, the term "vaporization" meets the real situation better than "atomization."

In present claims 30 and 31, replacing claims 10 and 11 (as found in the Annexes to the IPER), respectively, the added wording "for providing at least partially vaporized fuels" can be derived directly from the present specification (page 13, paragraph 3).

In connection with the objection to the specification, and the corresponding suggested changes, use of the Kelvin temperature scale ( $^{\circ}\text{K}$ ) creates no confusion, whatsoever, notwithstanding statements to the contrary set forth in the objection. Accordingly, the suggested changes being unnecessary, no such changes are made.

Claim 18 was rejected under 35 USC 112, first paragraph, as allegedly lacking descriptive support in the application as originally filed. The rejection is rendered moot by cancellation of claim 18, hereby. However, for the record, it is noted that the rejection is incorrect.

According to the statement of rejection, claim 18 is not supported by the written description of invention because claim 18 is a product-by-process claim, which "product is not explicitly defined and therefore it appears that claim 18 does not find support in the description of the instant specification" (Office Action, page 2).

The rejection under §112, ¶2, cannot be maintained because no reasoning sufficient to support the rejection is set forth in the statement of rejection. The alleged reason, i.e., that the product of product-by-process claim 18 "is not explicitly defined" in the specification (other than by its process of manufacture) is irrelevant. As set forth in MPEP 2173.05(p) (*emphasis added*):

A *product-by-process claim*, which is a product claim that defines the claimed product in terms of the process by which it is made, *is proper*. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); In re Steppan, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967).

Claims 1-19 were rejected under 35 USC 112, second paragraph, for allegedly being indefinite. Reconsideration is requested in view of the changes to the claims effected, hereby, taken in conjunction with the following remarks.

First of all, In connection with the rejection under §112, ¶2, applicants wish to thank the examiner for the helpful suggestions for replacement claim language for overcoming the rejection, set forth in the Office Action. Most of these suggestions have been incorporated into the present, replacement claims

In connection with the rejection as applied to original claims 2, 4, 5, 9, 10, 11, 14, 15, and 17, applicants have hereby incorporated the examiner's helpful suggestions for replacement claim language in order to overcome the section 112, paragraph 2 rejection as to the aforesaid, rejected claims. Accordingly, withdrawal of the rejection is in order.

The rejection of claim 18 under 35 USC 102(b) is rendered moot by cancellation of the rejected claim.

The rejection of "device" claim 20 under 35 USC 102(b) is invalid, since there was no claim 20 to reject. Claim 20 was cancelled during the international stage.

In connection with the §112, ¶2, rejection based on the alleged indefiniteness attributed to use of the Kelvin ( $^{\circ}$  K) temperature scale, and to reciting "bar" to define units of pressure, the rejection cannot be maintained.

The test for indefinite claim language is whether one of ordinary skill in the art would be confused as to the subject matter circumscribed by the claims. *In re Kroekel*, 183 USPQ 610 (CCPA 1974). Applying this test demonstrates that the language at issue satisfies the requirements of §112, ¶2.

In the instant situation, both " $^{\circ}$  K" (Kelvin) and "bar" represent units of measurement have well defined meanings in the art. For example *Merriam-Webster Medical Dictionary*, online at URL <http://www2.merriam-webster.com/cgi-bin/mwmednlm?book=Medical&va=kelvin> (printout page attached, hereto) defines "Kelvin" as "the base unit of temperature in the International System of Units that is equal to 1/273.16 of the Kelvin scale temperature of the triple point of water and also to the Celsius degree," and *Merriam-Webster Medical Dictionary*, online at URL

<http://www2.merriam-webster.com/cgi-bin/mwmednlm> (printout page attached, hereto) defines "bar" as "a unit of pressure equal to 100,000 pascals or to one million dynes per square centimeter or to 0.9869 atmosphere."

Moreover, it is applicant's sole prerogative to define the claims. *In re Pilkington*, 162 USPQ 145, 148 (CCPA 1969). That the PTO might prefer different claim terminology is not proper grounds for a rejection under §112, ¶2.

As such, withdrawal of the rejection under §112, ¶2, based on use of "° K" and "bar" in the claims is in order.

The section 112, paragraph 2, rejection as applied to claims 18 and 19 is rendered moot by cancellation of these claims.

The rejection under section 112, second paragraph, of claim 20 is invalid, since there was no original claim 20 to reject.

Applicants wish to thank the examiner for the indication of potentially allowable subject matter in original claims 1-17. Applicants have amended the claims substantially as suggested by the examiner, i.e., in order to overcome the rejection of record under §112, ¶2, and, therefore, render the claims (i.e, pending claims 20-36) allowable.

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Application No. 09/744,752

***Request for Acknowledgment of  
Foreign Priority Under 35 USC 119***

A claim to foreign priority under 35 USC 119 has been made (inventorship declaration, filed March 23, 2001) and the certified copy of the priority document received by the PTO (Notification of Acceptance, mailed 4 April 2001 by the PTO, and Form PCT/IB304, mailed 8 November 1999 by the International Bureau).

Accordingly, request is made that the Examiner mark the next Office Action to acknowledge, both, the claim to §119 priority and receipt of the certified copy.

Favorable action is requested.

Respectfully submitted,

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